

USSN: 09/757,175
Atty. Docket No.: 10234/2
Amdt. dated December 1, 2003
Reply to Office Action of August 29, 2003

REMARKS

Upon entry of the claim amendments, Claims 1, 3-5, 8-27, 29, and 31-38 will be all the claims pending in the application.

Claims 8-27 and 37 presently stand withdrawn.

Applicants, however, would like to remind the Examiner that with respect to Claim 27, where an applicant elects claims directed to a product, and a product claim is subsequently found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined (*see*, MPEP §821.04). In the present case, method claim 27 includes each and every limitation of product claim 1. Therefore, Applicants respectfully request the rejoinder of claim 27 should the Examiner deem claim 1 to be allowable.

Furthermore, Claims 8-26 and 37 are readable upon Species 2, and Claim 38 is a Markush-type claim generic to Species 1 and 2. A Markush-type claim can include independent and distinct inventions (*see*, MPEP §803.02). Following election, a Markush-type claim must be examined fully with respect to the elected species and further to the extent necessary to determine patentability.

Referring to the text of the Action, at Section No. 4 (bridging pages 2 and 3), Claims 1-7, 29-36, and 38 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being based on a non-enabling disclosure. The Examiner's position is that "[v]oids in the core layer is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure."

Applicants respectfully traverse.

In determining whether a feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 191 USPQ 429, 431 (CCPA 1976). Broad language in the disclosure omitting an allegedly critical feature rebuts the argument of criticality.

USSN: 09/757,175
Atty. Docket No.: 10234/2
Amdt. dated December 1, 2003
Reply to Office Action of August 29, 2003

First, the portion of the specification relied on by the Examiner to support the rejection (the paragraph bridging pages 6 and 7) does not state that "it is necessary" for the multilayered film of the present invention to have a core layer with voids.

Furthermore, and more importantly, the specification contains broad language rebutting the argument of criticality. Specifically, it is disclosed at the paragraph bridging pages 16 and 17 that "the opaque core layer ... is a thermoplastic polymer matrix material within which is *preferably* located a stratum of voids." It is also disclosed in the same paragraph that "[a]lthough one embodiment has a strata of voids located in the opaque core layer 14, it is possible to form an opaque core layer 14 that is substantially free of voids where the opacity is achieved by the addition of opacifying compounds."

Accordingly, Applicants respectfully request the withdrawal of this §112 rejection.

Turning to the prior art rejections, each of the rejections, which are presented at Section Nos. 5 and 6 of the Action, is based on U.S. Patent 4,758,462 to Park, *et al.* ("Park").

Applicants respectfully traverse.

Park does not disclose a film comprising an opaque core layer and a first skin layer containing a coloring agent, wherein each layer of the film is substantially free of voids. Instead, Park specifically discloses a film structure including a voided core layer. Applicants refer, for example, to Park's abstract and the description at column 3, lines 20-37. Accordingly, Park does not disclose (anticipate) or suggest (render obvious) the claimed invention.

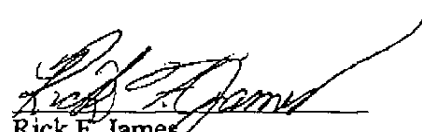
For the foregoing reason, Applicants respectfully request that the Examiner reconsider and withdraw the §102 and §103 rejections.

USSN: 09/757,175
Atty. Docket No.: 10234/2
Amdt. dated December 1, 2003
Reply to Office Action of August 29, 2003

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: December 1, 2003


Rick F. James
Registration No. 48,772

Post Office Address (to which correspondence is to be sent)
ExxonMobil Chemical Company
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone No. (281) 834-2438
Facsimile No. (281) 834-2495